

REMARKS

I. Restriction Requirement

In the Office Action, the Examiner requires restriction between the following groups:

- Group I - Claims 35-78, drawn to a makeup composition;
- Group II - Claims 79-81, drawn to a method of use;
- Group III - Claims 82 and 83, drawn to a method of use; and
- Group IV - Claim 84, drawn to a method of making.

See Office Action at 2.

While Applicant disagrees with the restriction requirement, Applicant provisionally elects, with traverse, to prosecute Group I, claims 35-78, drawn to a make-up composition.

The instant application is a national stage filing under 35 U.S.C. § 371 and thus unity of invention practice applies to the application. The Examiner contends that "Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the special technical feature common to all these groups is not novel. A makeup composition as described in pending claim 35 is described in U.S. Patent No. 6464969. Colorants are disclosed in the paragraph of line 64 of column 13, the liquid fatty phase is disclosed in line 7 of column 8, semi-crystalline polymers are taught in the paragraph of line 46 of column 3, and volatile oils are disclosed in line 37 of column 8." Office Action at 2.

Applicant respectfully traverses the restriction on the basis that it all of the present claims share the common technical relationship of a composition comprising the elements set forth in claim 1. See M.P.E.P. § 1893.03. The claims in Group I are drawn to a composition comprising the elements set forth in claim 1, the claims in Group II provide for applying a composition comprising the elements set forth in claim 1, the claims in Group III provide for obtaining a composition comprising the elements set forth in claim 1. Accordingly, at the very least, Groups I-III should be rejoined.

Applicant respectfully disagrees with the Office's analysis of U.S. Patent No. 6464969 and the conclusion that the patent anticipates the present invention. Applicant reserves any further response until the issuance of an official action directed towards the patent and the elected subject matter.

Applicants submit that the Examiner's restriction requirement is improper and should be withdrawn.

II. Election of Species

The Examiner also requires the following election of species;

- 1) *at least one volatile oil* (select a specific volatile oil or a specific combination of volatile oils), with claims 35-47, 77, 78, and 79 reading upon this species; and
- 2) *at least one semi-crystalline polymer* (select a specific polymer or a specific combination of polymers), with claims 35, 48-69, 71, 72, and 78-80 reading upon this species.

See Office Action at 3.

The election of species requirement is respectfully traversed. However, to be fully responsive, Applicant provisionally elects, with traverse:

- 1) for the specific volatile oil - isododecane (claims 35-37, 40-42, 44-84 reading on the species);
- 2) for the semi-crystalline polymer - a mixture of a homopolymer of behenyl acrylate, and a homopolymer of stearyl acrylate (claims 35-49, 62-78).

As with the restriction requirement discussed above, the Examiner merely asserted that "these species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1." The Office acknowledges that claims 35, 44-51, 62, and 71-77 are generic. Office Action at page 3.

If the election of species requirement is maintained, Applicant expects the Office, upon allowance of the elected species, to continue to examine the full scope of the subject matter presently claimed to the extent necessary to determine the patentability thereof, as is the duty according to 35 U.S.C. § 121 and M.P.E.P. § 803. Accordingly, for the reasons above, Applicant submits that the Examiner's election requirement is improper and should be withdrawn.

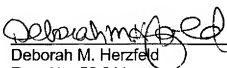
IV. Conclusion

In view of the foregoing remarks, Applicant respectfully requests reconsideration and examination of the claims. Please grant any extensions of time required to enter

this response and charge any additional required fees to our Deposit Account No.
06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: 
Deborah M. Herzfeld
Reg. No. 52,211

Dated: March 26, 2009